

Remarks

- 1) Applicant thanks the Examiner for his office action.
- 2) This correspondence is in response to an office action mailed to applicant on June 26, 2006.
- 3) Claims 1-6, 15, 16, 18, 19, 21-23, and 26-29 are pending in the application. Claims 27 - 29 are new, and represent subject matter to which the applicant is entitled and that has not been claimed heretofore.
- 4) Claim 6 stands rejected under 35 USC §102(e) as being anticipated by O'neal, US 6,711,154. Applicant's agent failed to see any mention in O'neal of the claimed features of a set-top box having a text to speech module executed thereupon, or a voice delivery module to the messaging system. As 102(e) requires THE INVENTION to be described, rather than parts thereof, applicant respectfully requests that the Office will point out specifically where ASLL CLAIM ELEMENTS of claim 6 are present in O'neal. Failing to do so, applicant submits that the rejection under section 102(e) was improper as NOT ALL CLAIM ELEMENTS ARE PRESENT in O'neal, and that it should be reconsidered and withdrawn.
- 5) Claims 27 through 29 represent yet another preferred embodiment of the invention, which relate to a system where the message is transmitted first to the television messaging system and from the television messaging system to the target messaging system. Applicant submits that none of the prior art cited, provides for the messaging television system to act as an intermediary between the set top box and the voice messaging system. Support for the claimed material may be found for example in paragraphs [008] and [036], and elsewhere in the application as filed.
- 6) Claims 1,2, 4-6 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over McKissick et al. (UEP 1458193) in view of Brunet et al. (US5,995,590). McKissick is directed to a television messaging system allowing the user to evaluate a currently viewed program and send the evaluation to a remote facility which uses the evaluation to generate overall evaluation of the television program (abstract, elsewhere). Applicant points out the clear immediate nature of the McKissick system, as opposed to the store and forward nature mandated by a messaging server such as a voice messaging server,

and the like. Brunet provides a system for text entry during a telephone conversation, where a user employs a unit including a keyboard to enter the text corresponding to what he wants to say. The text is converted into a synthesized speech using TTS apparatus and a voice output is sent to the microphone of the phone apparatus. The telephone apparatus transmits the synthesized voice signal over a standard telephone line to a unit including a conventional telephone speaker 26 and telephone microphone. The immediate nature of the communication is clearly shown in Brunet as well. Applicant further points out that neither patents mention a messaging system as claimed and described in the present invention.

- 7) Firstly, applicant notes that **neither references places the text to speech module as executable on the set-top box as claimed**. Moreover, the Brunet reference relates to real time speech and while the reference discuss converting speech back to text for delivery to an e-mail or a pager, the cited text (col. 4, ll. 27-32) **clearly does not disclose a delivery module to a messaging system capable of handling voice messages**, as claimed. Therefore, as neither McKissick nor Brunet provides either the execution of the text to speech module module on the set-top box, nor the transfer to a target voice enabled messaging system, the rejection is improper as NOT ALL CLAIM ELEMENTS ARE DISCLOSED.
- 8) In response to an argument made, the Office claimed that the “the concept of the combination of references is possible with the processor in the set top box of McKissick ... and the computer of Brunet inherently has to have a processor to function, so both references therefore are combinable”. Furthermore, the Office asserted that “outputting voice signals in the system of Brunet is the same as sending a message” and “...when two people are talking on a phone at the same time they are sending messages back and forth”. Applicant strongly rejects those notions as applied.
- 9) Regarding the motivation to combine based on the existence of a processor in both references, applicant would like to point out the present day pervasiveness of processors, ranging in applications from computers to watches, from microwave ovens to washing machines, from toilet seats to tractors. Yet there is little indication that will allow one to bind toilet seats and tractors, or to claim that washing machines and messaging systems are in analogous art or are combinable merely because they contain a processor. Basing

the combination on the fact that both references utilize a processor is akin to claiming that a sewer cleaning machine and a space shuttle are analogous and combinable merely because they both utilize nuts and bolts. The invention is not directed to a processor but to a novel and non-obvious apparatus that allows the user to send messages using a text entry device, the translation of such text entry into voice, and to the delivery of the voice to a messaging system. Applicant respectfully rejects that notion that the telephone or the computer of Brunet and the set top box of either McKissick or the present invention is combinable based on both having a 'processor' with both hands as arbitrary, capricious and irrational, and submits that the Office should reconsider and withdraw the rejection.

- 10) The argument that "outputting voice signals" is the same as sending a message, applicant respectfully submits that the Office did not provide the term 'message' the proper scope. As the message in the claim is clearly directed to a voice messaging system. *"The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest REASONABLE construction "IN LIGHT OF THE SPECIFICATION as it would be interpreted by one of ordinary skill in the art."* In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364[70 USPQ2d 1827] (Fed. Cir. 2004) (Emphasis added). The term voice messaging is widely held to relate to store and forward messaging. The specifications further provided examples of the meaning of the term "target messaging system" as "*a simple answering machine, to a cellular network, a unified messaging server, a voice mail server, a telephone network messaging system, and the like*" (paragraph [037]). It is clear therefore the Office provided the term 'message' a broader interpretation than what is reasonable in light of the specifications as mandated.
- 11) Applicant again points out that the Brunet reference (US5,995,590) relates merely to telephony system, and not to a text to voice messaging system in a television environment. Thus the Brunet patent relates to a different, non-analogous field or art, than both the McKissick patent and the present invention, and the references may not be properly combined.
- 12) The Office relies on *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992) to provide the reasoning why the television rating system of McKissick

may be properly combined with the telephone system of Brunet. Applicant refer the Office to the following text taken from MPEP 2141.01(a), describing *In re Oetiker*: (Applicant claimed an improvement in a hose clamp which differed from the prior art in the presence of a preassembly “hook” which maintained the preassembly condition of the clamp and disengaged automatically when the clamp was tightened. The Board relied upon a reference which disclosed a hook and eye fastener for use in garments, reasoning that all hooking problems are analogous. **The court held the reference was not within the field of applicant’s endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments.** The Commissioner further argued in the brief on appeal that a disengageable catch is a common everyday mechanical concept, however the court held that the Commissioner did not explain why a “catch” of unstated structure is such a concept, and why it would have made the claimed invention obvious.). (emphasis added). Similarly, the mere fact that that Brunet describes a text to speech converter is not reasonably pertinent to McKissick’s television rating system, without picking and choosing components based on applicant’s own teachings in the present application.

- 13) The Office argument provided to consider the Brunet patent as analogous art and therefore subject to proper combination with McKissick is that Brunet teaches a text to speech converter. Applicant respectfully points out that even in the application as filed, text to speech was recognized as old in the art (see paragraph [005]). McKissick does not teach nor hint a text to speech module operable in the set-top box and the mere existence of a reference that teaches a text to speech technology is insufficient to provide the motivation needed. *The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.* In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

- 14) The combination of a set top box executing a text to speech module is novel and non obvious, as by the Offices own admission, the mere reason for the combination is the existence in Brunet of a text to speech module. As applicant's agent failed to find in McKissick any reference, suggestion, or even a remote hint to a text to speech converter messaging system, or the desirability to convt text messages to voice, the combination made by the Office clearly constitutes using applicant's invention against himself, and an extremely clear case of IMPERMISSIBLE HINDSIGHT. (*"Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."*); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)
- 15) Inasmuch as the Examiner, despite the clear showing made above, may still consider the McKissik and Brunet references as properly combinable, applicant respectfully reminds the Office that: *The mere fact that the claimed invention is within the capabilities of one skilled in the art is not sufficient to establish obviousness (see MPEP 2143.01) and that "Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed";* *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (Emphasis added); *"Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment."* (*Al-Site Corp v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (fed. Cir. 1999). *"The factual inquiry whether to combine references must be thorough and searching."* *Id.* *It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.* See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000 (*"Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is*

rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). In re Lee, 277 F.3d 1338, 61USPQ2d 1430, (Fed. Cir.).

- 16) In re Lee, the court has clearly demanded that in order to combine references, there must be objective evidence of record of the motivation to combine. Neither McKissick nor Brunet, nor any other of the references cited provides such motivation. In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"). Applicant again submits that in the absence of clear and convincing motivation to combine the references without inexpressible hindsight, the Office failed to show prima facie obviousness as required by both in re Lee and in re Kotzab, and the rejection is improper and thus should be reconsidered and withdrawn.
- 17) Claim 4 stand rejected under the assertion that Brunet teaches transmitting synthesized speech to a telephone microphone to be transmitted. However neither Brunet nor McKissick teaches that the synthesized speech is to be to be transmitted to a VOICE MESSAGING SYSTEM, and Brunet specifically teaches away from this limitation as it is directed to real time operation between two telephones. Applicant again requests that the Office will provide a reasonable basis for equating a voice messaging system and a telephone, or reconsider and withdraw the rejection.
- 18) Applicant made a *bona fide* effort to address all the points raised by the Office, and believes he had overcome all the argument and the cited references that led to the rejections raised by the Office. Thus applicant respectfully requests that all

rejections be reconsidered and withdrawn and that the application will be allowed with all pending claims.

- 19) Should the Examiner find any deficiency in this amendment or in the application, or should the Examiner believe for any reason, that a conversation with applicant's agent may further the allowance and issuance of this application, the Examiner is kindly requested to contact Shalom Wertsberger at telephone (207) 799-9733.

Respectfully submitted

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